

REMARKS

Applicants have carefully reviewed the Office Action mailed July 24, 2008, in which claims 1 and 4-27 are pending and have been rejected. No amendments have been made with this response.

Claim Rejections under 35 U.S.C. §103

Claims 1 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Barbere (U.S. Patent No. 6,066,157) in view of Barath (U.S. Patent No. 5,616,149). Applicants respectfully traverse the rejection.

Barbere is directed to the balloon dilation catheter having an anchor joint that permits distal movement of the inner tube with respect to the outer tube while precluding proximal movement of the inner tube with respect to the outer tube. See abstract. Barbere discloses, in figure 1 for example, openings 22 in the outer tube. However, as noted in the Office Action at page 3, Barbere fails to disclose "wherein the plurality of distal openings are arranged about the outer tubular member in one or more longitudinally aligned sets." This, presumably, is because the two openings shown are not longitudinally aligned and either opening, by itself, cannot be a part of a longitudinally aligned set.

Barath is cited as remedying this deficiency, among others. However, Barath does not disclose the plurality of distal openings arranged about the outer tubular member in one or more longitudinally aligned sets. So far as Applicants can tell, the sole reference to side holes 5 in this patent is at column 4, lines 13-14: "the coaxial lumen serves to inflate the balloon through side holes (5). No reference is made as to the arrangement of these side holes. Further, the sole figure in the drawing that sheds any light at all on this issue is figure 1, in which the openings, so far as the reader is permitted to view, are not arranged in longitudinally aligned sets. Even the two openings which are generally on the front of the tube are longitudinally misaligned. None of the many cross-sectional views in Barath can shed any light on this issue of longitudinally aligned openings, because they show only a thin radial cross-section of the devices.

Therefore, neither of the cited references teaches this particular element of claim 1. As a result, the legal conclusion of obviousness cannot be gleaned on the basis of the facts found in the prior art as required by MPEP 2142. For at least this reason, Applicants therefore submit that

claim 1 is in condition for allowance, as well as claim 4, which depend therefrom and which contains additional elements.

Claim 5 was rejected under 35 U.S.C. §103 as being unpatentable over Barath and Barbere as applied to claim 1 above and further in view of Saab, US Pub No. 2006/0106336. Applicants respectfully traverse the rejection.

Saab does not, nor is alleged to, disclose any longitudinally aligned sets of openings, and consequently does not remedy the deficiency of the rejection of claim 1 above. Therefore, for at least the reason that claim 5 depends from claim 1 and contains additional elements, Applicants thus submit that this claim is also in condition for allowance.

Claims 6-8 and 10 were rejected under 35 U.S.C. §103 as being unpatentable over Barath and Barbere as applied to claim 1 above and further in view of Shaw, US Pat. No. 7,279,002. Applicants respectfully traverse the rejection.

Under 35 USC 103(c), Shaw is not available as prior art. Shaw is available as prior art to the present application, if at all, only under the provisions of 35 U.S.C. §102(e). Shaw was filed April 25, 2003 and did not publish until October 28, 2004, after the August 8, 2003 filing date of the present application. At the time the claimed invention of the present application was made, both the present application and Shaw were owned by the same person or subject to an obligation of assignment to the same person, as evidenced by the recorded assignments. Both were assigned to SciMed Life Systems at the time invention of the present application was made. (A Change of Name from SciMed Life Systems, to Boston Scientific Scimed, Inc. was subsequently recorded for the Shaw patent. As such, even though the current nominal assignee of the claimed invention is different from that of Shaw, each is still owned by the same entity.) Therefore for at least this reason, Applicants thus submit that claims 6-8 and 10 are in condition for allowance.

Claims 9 and 11-13 were rejected under 35 U.S.C. §103 as being unpatentable over Barath, Shaw and Barbere as applied to claim 7 above and further in view of Saab. Applicants respectfully traverse the rejection. For at least the reason that Shaw is not prior art, as discussed above with respect to claim 6, Applicants thus submit that these claims are also in condition for allowance.

Claims 14-15 and 21-22 were rejected under 35 U.S.C. §103 as being unpatentable over Barbere. Applicants respectfully traverse the rejection.

In this rejection, the Examiner asserts that Barbere discloses a first longitudinally aligned set of openings. However, what Barbere discloses in figure 1 is a latitudinally aligned set of openings. The openings in figure 1 of Barbere have the same relationship to a latitudinal, or transverse, axis of the device. Because they are not on the same side of the longitudinal axis, they do not share the same relationship to the longitudinal axis and therefore cannot be said to be longitudinally aligned. In contrast, for example, the top set of openings in Figure 2 of the present application share the same relationship to the longitudinal axis of the device; they are the same distance away from and in the same radial orientation to the longitudinal axis of the device and therefore can be said to be longitudinally aligned. The term radially is used in the corresponding sense in claim 19, which recites "wherein the first set of openings is radially aligned with the cutting member." This, Applicants believe, is understood to mean that the first set of openings and the cutting member are along the same radius. Thus, in figure 1 of Barbere, the two openings 22 cannot be said to be radially aligned. Even though they appear to be the same radial distance from the longitudinal axis of the device, they do not share the same radius. Applicants know of no other meanings for the terms longitudinally aligned and radially aligned that are used by those of skill in the art. Therefore, when the term longitudinally aligned is rightly understood, it can be seen that Barbere does not teach a first longitudinally aligned set of openings. For at least this reason, Applicants thus submit that the legal conclusion of obviousness cannot be reached on the basis of facts gleaned from the prior art, as required by MPEP 2142, and that claim 14 is consequently in condition for allowance, as well as claim 15 which depends therefrom and which contains additional limitations.

Further, both claim 14 and claim 21 recite "a cutting member coupled to the balloon." In item 7 on page 9 of the Office Action, the Examiner asserts that Barbere discloses a cutting member coupled to the balloon. Not only can Applicants find no reference to cutting members or the like in Barbere, but this assertion is in contradiction to one on page 3 of the Office Action where it is stated "Barbere fails to disclose one or more cutting members coupled to the balloon." Therefore, even if it were obvious as a matter of mere duplication to include a plurality of side lumens in the device of Barbere (a point which Applicants do not concede), such a modification would not result in the invention of either claim 14 or of claim 21. Therefore for at least this reason, Applicants thus submit that claims 14 and 21 are in condition for allowance, as well as claim 15 and 22 which depend therefrom and which contains additional elements.

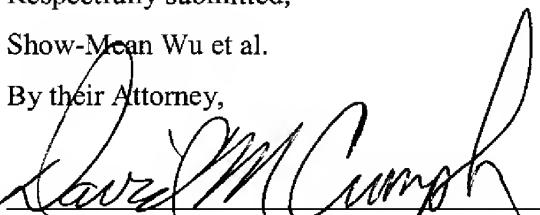
Claims 16-20 and 23-27 were rejected variously under 35 U.S.C. §103 as being unpatentable over Barbere as applied to claim 14 above and variously further in view of either Saab or Barath. For at least the reason that these claims depend from either claim 14 or claim 21, which Applicants submit are allowable and which contain additional elements, Applicants thus submit that these claims are also in condition for allowance.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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